

2



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,643	10/23/2000	Chung Chan	MTNC-103AX	9761
207	7590	11/30/2004	EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP			JACOBS, LASHONDA T	
TEN POST OFFICE SQUARE			ART UNIT	
BOSTON, MA 02109			PAPER NUMBER	

2157

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2

## Office Action Summary

Application No.

09/694,643

Applicant(s)

CHAN ET AL.

Examiner

LaShonda T Jacobs

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-22 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) 21,22 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is in response to Applicant's Amendment filed on September 27, 2004. Claims 18-27 are pending in this application. Claims 23 and 27 have been cancelled. Claims 18-22 and 24-26 are presented for further examination.

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121.

I. Claims 18-20, a method of connecting an extended wireless handheld unit having a visual screen to a server, the method comprising the steps of said handheld unit initiating a call to said server, etc., classified in class 707/10.

II. Claims 21-22 and 24-26 drawn to a method of providing customize information to a user over a communications network, the communications network including a private network and a public network, the private network comprising a plurality of territories, each territory including a plurality of regions, each region including at least one server, the user being connected to a first server in a first region within a first territory of the private network by a wireless extended handheld unit etc., classified in class 709/215.

2. The inventions are distinct, each from one another because of the following reasons:  
Inventions I and II are related as mutually exclusive species in an intermediate-final

Art Unit: 2157

product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3<sup>rd</sup> paragraph), and the species are patentably distinct (MPEP § 806.04(h)). Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Invention I is not required for Invention II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 2157

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

A telephone call was made to Richard Gamache regarding an election/restriction requirement by original presentation on November 16, 2004. Mr. Gamache elected Group I with traverse.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al (hereinafter, "Holmes", U.S. Pat. No. 6, 334,056) in view of Huang et al (hereinafter, "Huang", U.S. Pat. No. 6,477,543).

As per claim **18**, Holmes discloses a method of connecting an extended wireless handheld unit having a visual screen to a server, the method comprising the steps of:

- said handheld unit initiating a call to said server (abstract, col. 2, lines 9-15, col. 3, lines 52-59 and col. 4, lines 54-65);

Art Unit: 2157

- said handheld unit providing sender provided identification and security information to said server (col. 2, lines 16-29, col. 4, lines 9-18, lines 24-37 and col. 5, lines 3-26);
- said server combining said handheld unit identification and said sender provided information to authenticate said sender (col. 2, lines 16-29, col. 4, lines 9-18, lines 24-37 and col. 5, lines 3-26);
- if the connection is new, using the sender's security information to enable access to enrolled databases and services sender (col. 5, lines 29-52); and
- welcoming the user (col. 5, lines 29-52).

However, Holmes does not explicitly disclose:

- if the connection is a continuation of a previous connection that terminated abnormally, checking whether a complete screen had been sent;
- resending the previous screen when a complete screen had not been sent;
- sending the next screen of a sequence of screens had when further screens remain to be sent; and
- waiting for sender input.

Huang discloses a method, apparatus and program storage device for a client and adaptive synchronization and transformation server including:

- if the connection is a continuation of a previous connection that terminated abnormally, checking whether a complete screen had been sent (col. 10, lines 11-28 and lines 42-51);
- resending the previous screen when a complete screen had not been sent (col. 10, lines 11-28 and lines 42-51);

Art Unit: 2157

- sending the next screen of a sequence of screens had when further screens remain to be sent (col. 10, lines 65-67 and col. 11, lines 1-3); and
- waiting for sender input (col. 10, lines 11-28 and lines 42-51).

Given the teaching of Huang, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Holmes by terminating a connection if the user's authorization fails, resending the previous page and waiting for the user input in order to allow authorized users to access secure information over a network.

As per claim 19, Holmes discloses the invention substantially as claims discussed above.

However, Holmes does not explicitly disclose:

- wherein a call is initiated by the server.

Huang discloses a method, apparatus and program storage device for a client and adaptive synchronization and transformation server including:

- wherein a call is initiated by the server (col. 12, lines 30-34).

Given the teaching of Huang, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Holmes by initiating a call from server in order to establish communication between the server and user over a network.

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes in view Huang and in further view of Landgren.

As per claim 20, Holmes in view of Huang discloses the invention the substantially as claims discussed above:

However, Holmes in view of does not explicitly disclose:

Art Unit: 2157

- said server determining a location of said handheld unit;
- modifying a response to a user request by said location information unless a specific location is incorporated in said request.

Landgren discloses a system and method for appending location information to a communication sent from a mobile terminal operating in a wireless communication system to an Internet server including:

- said server determining a location of said handheld unit (abstract, col. 5, lines 52-67, col. 6, lines 1-4 and col. 9, lines 17-47);
- modifying a response to a user request by said location information unless a specific location is incorporated in said request (abstract, col. 5, lines 52-67, col. 6, lines 1-4 and col. 9, lines 17-47).

Given the teaching of Landgren, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Holmes in view of Huang by including a location appending unit in order to append location information concerning a mobile unit to communication passing through a gateway between the wireless network and Internet in order to determine a user's location in a timely and efficient manner.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 18-20 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Art Unit: 2157

U.S. Pat. No. 5,923,738 to Cardillo et al

U.S. Pat. No. 6,256,673 to Gayman et al

U.S. Pat. No. 6,535,243 to Tullis

U.S. Pat. No. 6,166,729 to Acosta

U.S. Pat. No. 6,430,591 to Goddard


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShonda T Jacobs whose telephone number is 571-272-4004. The examiner can normally be reached on 8:30 A.M.-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShonda T Jacobs  
Examiner  
Art Unit 2157

ltj  
November 17, 2004

  
SALEH NAJJAR  
PRIMARY EXAMINER